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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,051	12/18/2000	Gregory C. Flickinger	T900-11	4809
35465	7590	06/02/2005	EXAMINER	
GREGORY CHARLES FLICKINGER			ALPERT, JAMES M	
223 PHEASANT RUN SE			ART UNIT	
ROME, GA 30161			PAPER NUMBER	
			3624	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,051

Applicant(s)

FLICKINGER ET AL.

Examiner

James Alpert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 2/28/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The following communication is in response to Applicant's amendment filed via fax on February 28, 2005 (original having been mailed on November 13, 2004).

Status of Claims

Claims 1,3-4,12,14, are currently amended. Claims 2,5-11,13,15-18 are original. Claims 19-24 are new. All of Claims 1-24 are now pending.

Response to Arguments

Applicant's arguments filed 02/28/2005 have been fully considered but they are not persuasive as discussed below. Therefore, Claims 1-18 remain rejected as stated in the previous office action, and Claims 19-24 are further rejected as will be discussed below. Applicant's request for allowance is respectfully declined.

Arguments under Claim Rejections - 35 USC § 102,103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant initially argues that the Examiner may not use the Suliman et al., U.S. Patent Application #20010053980, to sustain rejections in that the provisional application supporting the utility application contains "significantly less disclosure." Although length of the document may be one factor to consider, MPEP 2136.03(III) states:

"The 35 U.S.C. 102(e) critical reference date of a U.S. patent ... entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application ... if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."

Art Unit: 3624

The Examiner has reviewed the provisional application, and has concluded that the disclosure, while not a word-for-word original of the published utility application, teaches and suggests the principles that the Examiner relies on when making his rejections based on the published utility application. Therefore, the Examiner is entitled to use, not only the disclosure of provisional application Serial #60/172351, but also the entirety of U.S. Patent Application #20010053980, Method and System for Blind Electronic Warranty Registration. Suliman anticipates claims 1,2,5,8,11-12,14, and 17-18, and Claims 3-4,6-7, 9, 13, and 15-16 are obvious in view of Suliman. Further, Suliman anticipates Claims 19-24.

With regard to Claims 1 and 12, the Applicant argues that amendments to this claim of,

"providing an electronic data file comprising data specific to an entity wherein the electronic data file is in the possession of the entity,"

remove the claims from the scope of Suliman. The examiner respectfully disagrees. At (Page 4 Para. 45), Suliman teaches:

"a consumer can use a smart card device, such as a smart card enabled credit card, that is capable of storing and operating software that could capture product information at the point-of-purchase. The product information could be communicated directly from the point-of-purchase to the registration system via a credit card network, through the credit card provider's bill processing system, or after download to another consumer device, such as the consumer's PC or WAP-enabled PDA or cell phone."

This passage clearly indicates that the data file will be portable and in possession of the purchaser. Applicant relies heavily on the fact that the data file and media as taught by Suliman are stored on a central server. However, Suliman teaches that:

"One skilled in the art will recognize that the registration system may as a matter of design choice include any number and configurations of servers, which may be used

Art Unit: 3624

separately or in tandem to support the traffic and processing needs necessary in operation at one time.” (Page 4 Para 41)

Thus, any distinction Applicant draws is given very little patentable weight in that Suliman suggest alternate configurations. In response to applicant's argument that the references fail to show certain benefits of applicant's invention, it is noted that the benefits upon which applicant relies must be recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). To the extent that the stated benefits are incorporated into rejected claims 1 and 18, these claims remain rejected as discussed above.

With regard to Claim 18, the Examiner disagrees with Applicant that Suliman does not disclose or suggest a media with a data file for use in automatically insuring assets. The examiner interprets this limitation broadly such that the word “insures” could be interpreted to include any kind of manufacturer's warranty or credit-card provided supplemental insurance. Thus when the product is registered by the system disclosed in Suliman, insurance is automatically forthcoming. Claim 18 remains rejected.

With regard to Claim 24, this claim will be discussed below/

With regard to dependent Claims 2-11, and 19-23, Applicant suggest there are several limitations that are not suggested or shown by the prior art. The Examiner respectfully disagrees, and notes that cited portions of Suliman appearing in the first office action on the merits (mailed 08/24/04) are not discussed. To be sure, a blanket statement that the claims are not supported by the prior art will not suffice.

With regard to Claim 7 and 16, the rejection of these claims under 35 U.S.C. 103(a) is hereby withdrawn. These claims are rejected under 35 U.S.C 102(e) as being anticipated by Suliman at (Page 4 Para. 45)

Claim Rejections - 35 USC § 103

With regard to Claims 3,4, and 13, the Applicant has asked the examiner to provide evidence that extracting a file remotely is old and well known. A very common example is what is known in Internet technology as a "cookie." Please consider Massarani et al, U.S. Patent Application #20030158889, Simulating Web Cookies for Non-Cookie Capable Browsers:

Many Web browsers have the capability to accept certain pieces (one or more packets) of information called cookies from Web sites visited. Cookies are transmitted by Web servers to the user (client) so that they are stored by the Web browser in the user's computer and read back by the server on subsequent visits by that user. **The cookie is automatically transmitted by the user's computer to the server on subsequent visits to that site.** Servers can collect information about the user including product or site preferences or other personal information provided by the user, and write that information or an access key to that information into the cookie... Cookies serve the purpose of identifying users and their preferences to Web sites over multiple visits to that site (Page 1 Para. 5)

Applicant further argues that "efficiency" is an improper motivation. The Examiner did not suggest that efficiency was the motivation. User friendliness is the stated motivation and remains valid. Claims 3,4, and 13 remain rejected under 35 U.S.C. 103(a).

With regard to Claims 6 and 15, Applicant has asked the examiner to provide evidence that credit card companies are interested in procuring information about users. A good example is found in Herz et al., U.S Patent #6571279, Location Enhanced Information Delivery System, at (Col. 6 line 17-33). Frederick describes the interest credit card companies have in knowing the spending patterns of their customers. This

Art Unit: 3624

fact also provides additional motivation for credit companies to be part of the registration process.

Applicant further argues that the motivation of a credit card company having a stake in the transaction is without merit because processing of warranty claims against credit card companies "is a different service." The Examiner can clearly envision why a financial company might want to keep abreast of goods purchased and registered by cardholders, for convenience, as well as to protect against fraud. Unless the Applicant can provide some evidence that this would not be beneficial to a card company, the Examiner disagrees that there is no motivation to combine. Finally, the Examiner does not rely on "efficiency" as an end, but rather considers the enhancements to customer service associated therewith to be sufficient motivation to combine. Claims 6 and 15 remain rejected.

With regard to Claim 9, in terms of the 35 U.S.C. 103(a) rejection, Applicant argues that Suliman does not expressly state that insurance is one of the provided services suggested in Paragraphs 14 or 63. These passages are clearly suggesting that supplemental services can become available to the purchaser. While Para. 14 discuss primarily repair services, Para. 63 does indicate that other type of services may become available, such as access to secondary markets sites. Suliman foresees "Other product related links" to be implemented within the scope of the registration process. Are insurance products so unique that they would fall outside a broad interpretation of this expression? The Examiner thinks not. To the extent that obtaining insurance to protect valuable items is an old and well known process in the financial art, it would have been

Art Unit: 3624

obvious to include in the system of Suliman, a process for automatically insuring some registered products. As such, Claim 9 remains rejected.

Claim Rejections - 35 USC § 102

With regard to Claim 19, Suliman teaches the method wherein:

said asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity directly providing said asset specific data.
(Page 4 Para. 45)

With regard to Claim 20, Suliman teaches the method wherein:

said asset data is obtained at the time of purchase of the asset.
(Page 4 Para. 45)

With regard to Claim 21, Suliman teaches the method wherein:

said data specific to an entity is extracted at the time of purchase of the asset.
(Page 4 Para. 45)

With regard to Claim 22, Suliman teaches the method wherein:

said data file is located on the entity's computer and at least a subset of said data specific to the entity is entered into the electronic data file by the entity.
(Page 3 Para. 37)

With regard to Claim 23, Suliman teaches the method wherein:

the entity is able to directly modify the entity specific data.

This limitation is an inherent part of the process of a registry system. That is to say, once a file is kept with regard to either a purchaser or a product, the ability to change personal information is always part of the process.

With regard to Claim 24, Suliman teaches the method comprising:

providing an electronic registration database;
(Page 2 Para. 11)

providing an electronic data file comprising data specific to an entity that purchases or owns assets;
(Page 3 Para. 37)

Art Unit: 3624

extracting the data specific to an entity from the electronic data file;
(Page 3 Para. 37)

entering data specific to an asset into the registration database where in said asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity directly providing said asset specific data;
(Page 3 Para. 37)

and associating data specific to the entity and data specific to the asset, thereby registering the asset for the entity
(Page 3 Para. 37; Page 10 Claim 1)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin

Art Unit: 3624

can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James M. Alpert
May 25, 2005



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